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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194115
Party	Plaintiff Latarie (Pty) Limited
Correspondence Address	MICHAEL CULVER MILLEN WHITE ZELANO BRANIGAN PC 2200 CLARENDON BLVD., SUITE 1400 ARLINGTON, VA 22201 UNITED STATES culver@mwzb.com
Submission	Motion for Sanctions
Filer's Name	Michael Culver
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Signature	/michaelculver/
Date	02/08/2012
Attachments	Motion for Sanctions.pdf ( 24 pages )(881618 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Latarie (Pty) Limited	)	
	)	
Opposer/Counterclaim Registrant	)	
	)	Opposition No. 91194115
v.	)	Appln. No. 77832433
	)	Mark: Zafrika
Robert Marx	)	
	)	
Applicant/Counterclaim Petitioner	)	

**OPPOSER'S MOTION FOR SANCTIONS,  
OR, ALTERNATIVELY, TO COMPEL RESPONSES TO DISCOVERY**

Latarie (Pty) Limited, as Opposer and Counterclaim Registrant ("Latarie"), submits this motion for sanctions (or, alternatively, to compel responses to discovery) against Robert Marx, as Applicant and Counterclaim Petitioner ("Marx"). This motion is supported by the facts and arguments submitted below, as well as the facts submitted in the Motion to Withdraw filed January 27, 2012 by Carl E. Christensen with respect to his representation of Marx.

**Factual Statement**

On October 14, 2011, Latarie served Opposer's First Set of Interrogatories to Applicant (Exhibit A hereto) and Opposer's First Set of Document Requests (Exhibit B hereto). Responses thereto by Marx were thus due by November 18, 2011. Mr. Christensen, on behalf of Marx, requested extensions of time to respond to the foregoing discovery and Latarie consented so that Marx's responses were due by December 27, 2011. *See* Motion to Withdraw (Docket # 17) at ¶ 1. On December 27, Mr. Christensen indicated that responses would be made in a day or two. *See* Email of Mr. Christensen

(Exhibit C). Thereafter, discovery responses by Marx were not forthcoming and, according to Mr. Christensen, Marx refused to cooperate, or even communicate, with his own counsel. *See* Motion to Withdraw ¶¶ 2-4.

Mr. Christensen and Latarie’s counsel communicated between December 27 and January 24; however, those communications did not resolve the impasse created by Marx. Mr. Christensen’s email to Latarie’s counsel on January 24 stated: “You will either have it [discovery responses] on Monday, or I will be requesting to withdraw from this matter.” *See* Exhibit D.

On January 27, 2012, Mr. Christensen filed his Motion to Withdraw which relied in part on the provisions for mandatory withdrawal. *See id.* p. 1 (citing TBMP 116.03 which incorporates 37 CFR § 10.40(b)). With respect to § 10.40(b), Mr. Christensen’s Motion to Withdraw contains no facts relating to subsection (3) (the “practitioner’s mental or physical condition”) or subsection (4) (the “practitioner is discharged by the client”). Subsections (1) and (2) thereof provide the following:

- (1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;
- (2) The practitioner knows or it is obvious that the practitioner’s continued employment will result in violation of a Disciplinary Rule [.]

### Argument

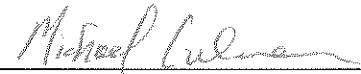
Pursuant to 37 CFR § 2.120(g)(2), the Board may issue an order for sanctions, including rendering final judgment under subsection (g)(1), when a party “informs the party seeking discovery that no response will be made thereto ....” Based on the foregoing facts, it is obvious that Marx will not respond to Latarie’s discovery requests.

Further, Mr. Christensen's Motion to Withdraw has effectively stated that Marx will not so respond or even communicate with his counsel. Marx's silence and the Motion to Withdraw are equally compelling to "inform" Latarie; that is, to make known or impart this knowledge. It is also clear that Marx has some improper purpose afoot by his refusal to respond to discovery, hence the compelled withdrawal of his counsel.

Under these circumstances, the Board should not tolerate Marx's obstinacy and should issue an order rendering final judgment in favor of Latarie on all claims in this action. Alternatively, at a minimum, the Board should compel Marx to forthwith respond to all outstanding discovery requests and to do so by waiving any objections.

Date: February 8, 2012

Respectfully submitted,

By:   
Michael Culver  
Millen, White, Zelano & Branigan, P.C.  
2200 Clarendon Blvd., Suite 1400  
Tel: 703-243-6333  
Fax: 703-243-6410  
culver@mwzb.com

Attorneys for Opposer

Certificate of Service

This is to certify that a copy of the foregoing was served this 8<sup>th</sup> day of February 2012 by first class mail, postage prepaid, on the following:

Carl E. Christensen, Esq.  
CHRISTENSEN LAW OFFICE PLLC  
Suite 704  
800 Washington Avenue North  
Minneapolis, MN 55401

Robert Marx  
P.O. Box 643  
26643 Fallbrook Avenue (Bay H)  
Wyoming, MN 55092

By: Michael Culver  
Attorney for Opposer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Latarie (Pty) Limited )  
)  
Opposer/Counterclaim Registrant )  
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v. )  
)  
Robert Marx )  
)  
Applicant/Counterclaim Petitioner )

Opposition No. 91194115  
Appln. No. 77832433  
Mark: Zafrika

OPPOSER'S MOTION FOR SANCTIONS,  
OR, ALTERNATIVELY, TO COMPEL RESPONSES TO DISCOVERY

Exhibit A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Latarie (Pty) Limited	)	
	)	
Opposer/Counterclaim Registrant	)	
	)	
v.	)	Opposition No. 91194115
	)	Appln. No. 77832433
Robert Marx	)	Mark: Zafrika
	)	
Applicant/Counterclaim Petitioner	)	

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**

Opposer hereby requests that Applicant completely and separately answer in writing under oath the following Interrogatories in accordance with 37 CFR § 2.120 and Rule 33 of the Federal Rules of Civil Procedure.

Definitions and guidelines for these Interrogatories are set forth in an Appendix hereto.

**INTERROGATORY NO. 1**

Describe the methods, or intended methods, for advertising and promoting in the United States the goods identified by Applicant's Mark.

**INTERROGATORY NO. 2**

State the price or price range (or intended price or price range) for the goods identified by Applicant's Mark.

**INTERROGATORY NO. 3**

State the facts surrounding the circumstances of the conception, adoption and selection of Applicant's Mark.

**INTERROGATORY NO. 4**

State the facts supporting any meaning, derivation, significance or commercial impression of the wording in Applicant's Mark.

**INTERROGATORY NO. 5**

State whether Applicant is aware of any communication concerning (A) any instance of actual confusion with respect to the marks ZARàFA and Zafrika, or (B) any instance when a person mistakenly made any association, affiliation or connection between Applicant and Opposer or the marks ZARàFA and Zafrika or the goods identified thereby; and, if so, describe the circumstances surrounding such communication, including the date thereof and persons having knowledge thereof.

**INTERROGATORY NO. 6**

Setting aside any contentions by Applicant regarding validity or ownership, if Applicant contends that there is not a likelihood of confusion between the marks ZARàFA and Zafrika, state the facts supporting such contention.

**INTERROGATORY NO. 7**

State when Applicant first became aware of the mark ZARàFA and describe the circumstances surrounding such awareness.

**INTERROGATORY NO. 8**

State when Applicant first became aware of the U.S. registration of the mark ZARàFA and describe the circumstances surrounding such awareness.

**INTERROGATORY NO. 9**

Identify all communications that evidence or support any contention by Applicant that Applicant is the owner of the mark ZARàFA.



**INTERROGATORY NO. 10**

Identify all communications that evidence or support any contention by Applicant that Applicant has controlled the nature and quality of the goods identified by the mark ZARàFA.

**INTERROGATORY NO. 11**

Identify all communications that evidence or support any contention by Applicant that Applicant has controlled the packaging for the goods identified by the mark ZARàFA, including any artwork or text for such packaging.

**INTERROGATORY NO. 12**

With respect to Applicant's Amended Counterclaim and Petition for Cancellation, state the facts supporting Applicant's pleading in paragraphs 2-4 inclusive, including Applicant's communications and business dealings with Trader Joe's.

**INTERROGATORY NO. 13**

Identify all agreements (written or oral) between Opposer and Applicant that refer or relate to the mark ZARàFA or ownership thereof or the terms and conditions for any transactions between Opposer and Applicant regarding the sale or marketing of wine.

**INTERROGATORY NO. 13**

With respect to Applicant's Amended Counterclaim and Petition for Cancellation, state the facts supporting Applicant's contentions that Opposer knowingly made false, material misrepresentations to the Patent and Trademark Office and that in doing so Opposer had the intent to deceive the Patent and Trademark Office.

Date: October 14, 2011

By: Michael Culver  
Michael Culver

Millen, White, Zelano & Branigan, P.C.  
2200 Clarendon Blvd., Suite 1400  
Tel: 703-243-6333  
Fax: 703-243-6410  
culver@mwzb.com

Attorneys for Opposer

Certificate of Service

This is to certify that a copy of the foregoing was served this 14<sup>th</sup> day of October 2011 by first class mail, postage prepaid, on the following:

Carl E. Christensen, Esq.  
CHRISTENSEN LAW OFFICE PLLC  
Suite 704  
800 Washington Avenue North  
Minneapolis, MN 55401

By: Michael Culver  
Attorney for Opposer

## APPENDIX

### DEFINITIONS AND GUIDELINES

For the purpose of these Interrogatories, the following definitions and guidelines shall apply:

1. "Opposer" means Latarie (PTY) Limited as the plaintiff in the above-captioned matter and any of its related companies, including Mountain River Wines (PTY) LTD or Mountain River Group.
2. "Applicant" means Robert Marx as the defendant in the above-captioned matter, and any company controlled or principally owned by Robert Marx involved in the marketing or production of wine, including MT Global, LLC or MT Global Wine.
3. "Person" means, without limitation, any natural person, juristic person or business entity such as an association, business organization, partnership, corporation, governmental organization, or formal or informal group or subdivision thereof, and his, her, or its officers, directors, employees, attorneys, agents, or representatives and all other persons acting or purporting to act on behalf of the person.
4. "Communication" means the transmittal of information in the form of facts, data, ideas, inquiries or otherwise, whether electronic, written or oral or transmitted by any other means.
5. "Document" shall be defined to the broadest extent possible permitted by Fed. R. Civ. P. 34 to mean any communication, whether recorded, printed, written, obtained, stored, compiled, produced or reproduced by any mechanical, electrical or electronic processes or by hand.

Any copy of a document other than the exact duplicate of that document is a separate document. Likewise, foreign language documents, English language equivalents and English translations are separate documents.

6. "Thing" includes any tangible object.

7. The word "identify" with respect to a person means to provide the full name and the present or last known postal and e-mail address, web site, telephone number and employer. If used in reference to a document or thing, the word "identify" means to provide the identity of the person who authored or created the document or thing, the identify of any person to whom it was addressed or sent, the date of the document or thing, the nature of the document or thing (e.g., letter, memorandum, etc.), with sufficient detail as would be necessary for a request for production of such document or thing and the names of any persons who have control of the original document or thing.

In lieu of "identifying" a document or thing, Applicant may produce a copy of any such document, or a duplicate of any such thing, with the answers to these Interrogatories and document requests, if such copy or duplicate is expressly labeled to correlate it to each and every Interrogatory, document request and/or portion thereof to which it is at least in part a response.

8. The terms "and", "or", and "and/or" and "/" are to be interpreted both in the conjunctive and the disjunctive, as necessary to bring within the scope of an interrogatory or document request any response, document or thing which might otherwise be construed to be outside its scope.

9. Wherever appropriate herein, the singular form of a word shall be interpreted to include the plural, and the plural shall be interpreted to include the singular, as necessary

to bring within the scope of an interrogatory or document request any response, document or thing which might otherwise be construed to be outside its scope.

10. Wherever appropriate herein, the tense of a verb shall be interpreted to include the past and present as necessary to bring within the scope of an interrogatory or document request any response which might otherwise be construed to be outside its scope.

11. The phrases "referring or relating to" and "refer or relate to" encompass all information, communications, documents and things which have a legal, factual or logical connection, relationship, correlation, or association with the stated subject matter in any way, regardless of whether it would tend to support, prove, rebut or disprove the position of any party concerning that subject matter.

12. If any document or thing identified in response to an Interrogatory or called for by a document request has been destroyed, state, with regard to such destruction, (i) the date of such destruction, (ii) the reason for such destruction, (iii) the identify of the person(s) who destroyed the document or thing, and (iv) the identity of the person(s) who authorized such destruction.

13. Each response shall be made based upon your entire knowledge, acquired with due diligence and available from all sources, including all information in your possession, custody or control, or that of your agents, representatives or attorneys.

14. If you cannot respond to an interrogatory in full after excising due diligence to secure the information necessary to do so, please set forth your efforts to ascertain the answer and respond to the extent possible.

15. If you qualify a response in any manner, please set forth the exact nature and extent of the qualification.
16. Unless otherwise specified in an individual interrogatory, these interrogatories are not limited to any time period.
17. If any interrogatory is objected to, state with specificity the reasons for the objection and provide an answer to that portion of the interrogatory that is not objectionable.
18. "Applicant's Mark" is the mark ZAFRIKA that is the subject of Application No. 77/832,433.

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Opposer/Counterclaim Registrant )  
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Robert Marx )  
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Applicant/Counterclaim Petitioner )

Opposition No. 91194115  
Appln. No. 77832433  
Mark: Zafrika

**OPPOSER'S MOTION FOR SANCTIONS,  
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Exhibit B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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	)	
Opposer/Counterclaim Registrant	)	
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v.	)	Opposition No. 91194115
	)	Appln. No. 77832433
	)	Mark: Zafrika
Robert Marx	)	
	)	
Applicant/Counterclaim Petitioner	)	

**OPPOSER'S FIRST SET OF DOCUMENT REQUESTS**

Opposer hereby requests that Applicant produce all documents and things within Applicant's possession, custody or control that are requested in the following requests for production in accordance with 37 CFR § 2.120 and Rule 34 of the Federal Rules of Civil Procedure.

Applicant is requested to produce all such documents and things within thirty days of service at the offices of Opposer's counsel, Millen, White, Zelano & Branigan, P.C., 2200 Clarendon Boulevard, Suite 1400, Arlington, VA 22201, or at such other location as counsel for the parties may mutually agree.

Applicant is further requested to produce such documents and things as they are kept in the usual course of business and to specify in the written response to each production request, and on labels on the documents and things produced, the production request or subpart thereof to which each document and thing is responsive as required by Rule 34 of the Federal Rules of Civil Procedure.

For the purpose of the following requests for production, the Definitions and Guidelines set forth in Opposer's First Set of Interrogatories to Applicant shall govern.



## REQUESTS FOR PRODUCTION

### REQUEST NO. 1

Representative documents and things, including labels, packaging and other indicia, showing each different use, or intended use, of Applicant's Mark on or in connection with any goods identified thereby.

### REQUEST NO. 2

All documents referring or relating to the advertising and promotion (actual or intended) of Applicant's Mark or the goods identified thereby.

### REQUEST NO. 3

All documents referring or relating to the conception, selection and/or adoption of Applicant's Mark.

### REQUEST NO. 4

All documents referring or relating to any meaning, derivation, significance and/or commercial impression of the wording in Applicant's Mark.

### REQUEST NO. 5

All documents created on or prior to the September 22, 2009 filing date of Application No. 77/832,433 that refer or relate to Applicant's bona fide intention to use Applicant's Mark.

### REQUEST NO. 6

All documents referring or relating to the first use of Applicant's Mark.

### REQUEST NO. 7

All documents referring or relating to Applicant's first awareness of the mark ZARàFA.

**REQUEST NO. 8**

All documents referring or relating to any surveys, studies, analysis and/or polls with respect to Applicant's Mark, including any criteria, strategy or market plan with respect to Applicant's Mark.

**REQUEST NO. 9**

All documents referring or relating to any customer or informational profile for purchasers or prospective purchasers of goods identified by Applicant's Mark, including, for example, purchasing decisions, buying habits, and alternative or competitive product choices.

**REQUEST NO. 10**

All documents showing any unsolicited communication in the media that refers or relates to Applicant's Mark.

**REQUEST NO. 11**

All documents referring or relating to any product review or other communication by persons other than Applicant that refer or relate to the goods identified by Applicant's mark.

**REQUEST NO. 12**

All documents referring or relating to the conception, selection and/or adoption of any design and/or artwork of product labels used in connection with Applicant's Mark.

**REQUEST NO. 13**

All documents referring or relating to any trademark search for the marks ZARàFA or Zafrika conducted by or on behalf of Applicant.

**REQUEST NO. 14**

All documents referring or relating to (A) any actual confusion with respect to the marks ZARàFA and Zafrika or (B) any instance when a person mistakenly made any affiliation, association or connection between Applicant and Opposer or the marks ZARàFA and Zafrika or the goods identified thereby.

**REQUEST NO. 15**

All documents and things evidencing or supporting any contention by Applicant that there is not a likelihood of confusion between the marks ZARàFA and Zafrika.

**REQUEST NO. 16**

All documents evidencing, supporting, referring or relating to Applicant's ownership of the mark ZARàFA.

**REQUEST NO. 17**

All documents evidencing, supporting, referring or relating to Applicant's control over the nature and quality of the goods identified by the mark ZARàFA.

**REQUEST NO. 18**

All documents evidencing, supporting, referring or relating Applicant's ownership of any design and/or artwork for packaging used in connection with the mark ZARàFA.

**REQUEST NO. 19**

With respect to Applicant's Amended Counterclaim and Petition for Cancellation, all documents evidencing, supporting, referring or relating to Applicant's pleading in paragraphs 2-4 inclusive, including Applicant's communications and business dealings with Trader Joe's.

**REQUEST NO. 20**

All documents evidencing, supporting, referring or relating to any agreement (written or oral) between Opposer and Applicant that refers or relates to the mark ZARàFA or ownership thereof or the terms and conditions for any transactions between Opposer and Applicant regarding the sale or marketing of wine.

**REQUEST NO. 21**

All documents referring or relating to any use of the mark ZARàFA for wine by a person other than Opposer or Applicant.

**REQUEST NO. 22**

All documents referring or relating to any communication between Applicant and any person other than Opposer that refers or relates to the mark ZARàFA for wine.

**REQUEST NO. 23**

With respect to Applicant's Amended Counterclaim and Petition for Cancellation, all documents evidencing, supporting, referring or relating to Applicant's pleading that Opposer knowingly made false, material misrepresentations to the Patent and Trademark Office and that in doing so Opposer had the intent to deceive the Patent and Trademark Office.

Date: October 14, 2011

By: 

Michael Culver  
Millen, White, Zelano & Branigan, P.C.  
2200 Clarendon Blvd., Suite 1400  
Tel: 703-243-6333  
Fax: 703-243-6410  
culver@mwzb.com

Attorneys for Opposer

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Carl E. Christensen, Esq.  
CHRISTENSEN LAW OFFICE PLLC  
Suite 704  
800 Washington Avenue North  
Minneapolis, MN 55401

By: Michael C. Christensen  
Attorney for Opposer

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Applicant/Counterclaim Petitioner	)	

**OPPOSER'S MOTION FOR SANCTIONS,  
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Exhibit C

## Michael Culver

---

**From:** Carl Christensen [carl@clawoffice.com]  
**Sent:** Tuesday, December 27, 2011 7:55 PM  
**To:** Michael Culver  
**Subject:** Marx Responses.

Michael.

Happy holidays. The discovery is out to my client for final approval and execution. I hope to have it to you tomorrow and by Thursday at the latest. Thank you for your patience.

Yours,

Carl

**CHRISTENSEN**

LAW OFFICE PLLC

Carl Christensen  
Christensen Law Office PLLC  
800 Washington Avenue North  
Suite 704  
Minneapolis, MN 55401  
Phone: 612-823-4427  
Fax: 612-823-4777

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OPPOSER'S MOTION FOR SANCTIONS,  
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Exhibit D



## Michael Culver

---

**From:** Carl Christensen [carl@clawoffice.com]  
**Sent:** Tuesday, January 24, 2012 2:33 PM  
**To:** Michael Culver  
**Subject:** Re: Discovery: Zafrika Opposition

Mike,

Thank you for your email. You will either have it on Monday, or I will be requesting to withdraw from this matter.

Yours,

Carl



Carl Christensen  
Christensen Law Office PLLC  
800 Washington Avenue North  
Suite 704  
Minneapolis, MN 55401  
Phone: 612-823-4427  
Fax: 612-823-4777

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